82-1274

NO. ____

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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1982

TIMBERLAND MACHINES AND ENGINEERING CORP., E. HOWARD SWAFFORD, FREDERICK L. MILLER,
PETITIONERS,

v.

MAINLAND INDUSTRIES, INC.,
RESPONDENT.

PETITION FOR A WRIT OF CERTIORARI TO THE COURT OF APPEALS OF OREGON

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QUESTION PRESENTED

Whether the Oregon Court of Appeals misapplied the law of master-servant as enunciated by this Court in the seminal case of United States v. Dubilier Condenser Corp., 289 U.S. 178 (1933).

TABLE OF CONTENTS

	Page
Opinions Below	2
Jurisdiction	2
Constitutional Provisions Involved	2
Statement of the Case	3
Reasons for Granting the Writ	14
(1) The decision below conflicts with this Court's decision in United States v. Dubilier Condenser Corp., 289 U.S. 178 (1933)	14
(2) The Court has not for fifty years passed on the question of ownership of inventions by employed persons	27
Conclusion	28
Appendix	A-1
Opinion of the Court of Appeals of Oregon	A-1

TABLE OF CONTENTS (cont'd)

	Page
Memorandum Opinion of the Clackamas Circuit Court of Oregon	A-30
Denial of Petition for Review by Oregon Supreme Court	A-94

TABLE OF AUTHORITIES

Page

Cases

Bandag, Inc. v. Morenings, 146 N.W.2d 916, 152 U.S.P.Q. 353 (Iowa 1966) 16,24

Cambridge Wire Cloth Co. v. Applegarth, 141 U.S.P.Q. 44 (Md. Cir. Ct. 1964) 16,24

Chilton v. Comr. Internal Revenue, 40 T.Ct. 552, 138 U.S.P.Q. 336 (1963) 16,24

Logus Mfg. Corp. v. Nelson, 195 U.S.P.Q. 566 (E.D.N.Y.), aff'd on rehearing, 200 U.S.P.Q. 570 (E.D.N.Y. 1977) 16,24

Melin v. United States, 478 F.2d 1210, 177 U.S.P.Q. 580 (Ct. Cl. 1973) 16,24

Mosser Industries, Inc. v. Hagar, 200 U.S.P.Q. 608 (Pn. Ct. C. Pleas. 1978) 16,24

United States v. Dubilier Condenser Corp., 289 U.S. 178, 53 S.Ct. 554, 77 L.Ed. 1114 (1933) 12,13,14, 15,16,17, 18,22,23, 28

Ushakoff v. United States, 327 F.2d 669, 140 U.S.P.Q. 341 (Ct. Cl. 1964) 16

TABLE OF AUTHORITIES (cont'd)

Page

Cases

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Deller's Walker on Patents, 2d ed., title 378 16

"The Law of the Employed Inventor - Time for a Change?", 57 Mass. L.Q. 27, 37 (1972) 28

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October Term, 1982

TIMBERLAND MACHINES AND ENGINEERING CORP., E. HOWARD SWAFFORD, FREDERICK L. MILLER,
Petitioners,

v.

MAINLAND INDUSTRIES, INC.,
Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE COURT OF APPEALS OF OREGON

The petitioners, Timberland Machines and Engineering Corp., E. Howard Swafford, and Frederick L. Miller respectfully pray that a writ of certiorari issue to review the judgment and opinion of the Court of Appeals of Oregon, entered in this proceeding on August 18, 1982.

OPINIONS BELOW

The opinion of the Oregon Court of Appeals appears in 58 Or.App. 585, 649 P.2d 613 (1982). The Memorandum Opinion of the Clackamas Circuit Court of Oregon was not published. Both opinions appear in the Appendix hereto.

JURISDICTION

The judgment of the Oregon Court of Appeals was entered on August 18, 1982. A timely petition for review in the Oregon Supreme Court was denied on November 2, 1982, and this petition for certiorari was filed within 90 days of that date. This Court's jurisdiction is invoked under 28 U.S.C. § 1257(3).

CONSTITUTIONAL PROVISIONS INVOLVED

Article 1, section 8 of the United States Constitution provides in pertinent part:

> "The Congress shall have Power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries . . ."

The Fourteenth Amendment of the United States Constitution provides in pertinent part:

> "nor shall any State deprive any person of life, liberty, or property, without due process of law."

STATEMENT OF THE CASE

Alfred Maede founded Chipper Machines and Engineering Corp. ("CM&E") in 1953, and shortly thereafter hired petitioner Frederick L. Miller. The business of CM&E was primarily marketing a line of wood chippers. Miller was hired in a general capacity with his duties including sales, inspection of equipment that was manufactured, shop problems regarding drawing or manufacturing

errors, all incidental troubleshooting, field installations, servicing equipment, and training field and mill personnel to operate and troubleshoot the equipment. Tr. 139, 197, 349-50, and 587.[1] There was no evidence adduced to show that he was hired specifically to invent.

Before his employment by CM&E, Miller had over the years established a practice of inventing and obtaining patents on his inventions. Prior to accepting employment with CM&E, he informed Maede that he intended to continue his practice of inventing and patenting inventions on his own. Consequently, Miller and Maede for CM&E orally agreed that anything Miller invented on his own time, money and

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[1]The transcript of the trial in the Clackamas Circuit Court will be here referred to as "Tr.".

facilities would be retained by him, and anything he invented on CM&E's time, money and facilities would be assigned to CM&E. Tr. 350-51. Three impartial witnesses, Edmond Gurney (a CM&E employee from 1953 to 1975 and former corporate president); Harold Elford (a private business person who retained Miller as a consulting engineer in 1956 based on Maede's recommendation); and Lee Schermerhorn (Miller's and CM&E's patent attorney), confirmed the existence and terms of that agreement, as testified to by Miller. Tr. 684-87, 715-20, and 734-37. Edmond Gurney also testified that sometime after he was employed, he suggested to Maede that new employees be required to assign inventions to CM&E, but that the policy was never implemented. When Maede discussed implementation of the policy with Miller, Gurney

testified that "the outcome of the discussion was that Fred's right to his work, his own particularly outside of work was his own, belonged to him, to no one else." Tr. 718-20.

Moreover, no evidence was ever introduced at trial by plaintiff that controverted the existence or the terms of the oral agreement, as testified to by Miller. For over twenty years the parties operated harmoniously under that oral agreement, during which time CM&E prospered significantly under the agreement with Miller.

After Maede died, plaintiff, Mainland Industries, Inc., purchased CM&E in December, 1975. Miller continued his employment with CM&E/Mainland.[2] The only change with respect to

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[2]Because the name of the business was not changed to Mainland, "CM&E/Mainland" will be used to denote CM&E after its acquisition by Mainland.

Miller's employment was that his sales activities were to be curtailed and that he was requested to focus on his engineering duties which still included trouble-shooting, fielding customer complaints and supervising engineering personnel. At no time did CM&E/Mainland request Miller to enter into any agreement, oral or written, regarding assignment of inventions or non-competition. Tr. 55-57, 179, 189, and 562.

Miller retired from CM&E/Mainland in February, 1978, upon reaching the age of 65. Shortly thereafter he joined petitioner Timberland Machines and Engineering Corp. (Timberland), which had been incorporated by petitioner E. Howard Swafford. Swafford had previously worked as comptroller for CM&E/Mainland.

From 1953 to April, 1978, Miller obtained six patents, all relating to

woodworking machinery. Pursuant to the Miller-CM&E agreement, three of those patents were assigned by Miller to CM&E and three were retained by Miller as his personal property. With respect to the patents Miller retained, he personally paid for all patent work, and all correspondence and other matters relating to those patents were conducted from his own house and not from the offices of CM&E. CM&E was well aware of Miller's retention of ownership of his inventions made on his own time, money and facilities, and no question was ever raised as to his ownership. Tr. 328-30, 718-19, 730; Exhibits 30, 153, 154, 155, 188, and 190.[3]

In regard to the 1978 knifeholder patent (subject of present suit),

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[3]Exhibits 188 and 190 were admitted post trial.

this regard was given by Gene Hill, CM&E/Mainland's manager, who said he was unaware of any problems with the 1973 knifeholder until 1979. Tr. 31, 63-65. Moveover, Edmond Gurney, president of CM&E from 1973 to 1975 did not recall any problem with respect to plugging or jamming of the 1973 knifeholder. He believed such problems would have been brought to his attention because he generally fielded customer complaints. Tr. 720. From out of its 400 to 500 chipping heads in use, which employ over 3,000 knifeholders (8 per machine), CM&E/Mainland made only two service calls to correct alleged problems with the 1973 knifeholder. Tr. 446-47. In both cases, problems with the knife-

holder were due to customer misuse of the equipment.[4]

Although CM&E/Mainland's manager assigned Miller the duties of designing a waste wood chipper and a saw edger, he never asked Miller to design or to invent an improved knifeholder. Tr. 74-75. In fact, even at the time of trial, Hill had never assigned to any employee the task of designing or inventing an improved knifeholder, because of any problems or for any other reason. Tr. 75.

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[4]The complaint from the British Columbia customer (Whonnock Mills), referred to in the Court of Appeals decision, was reported in March, 1977. Actually, the mill reported a total of twenty-one problems, only one of which related to the knifeholder itself. These problems were due to abuse of the machine by putting logs through which exceeded the chipper's capacity, as testified to by Mr. Zacharias, a sales employee of plaintiff's familiar with the situation at Whonnock. Tr. 414-15.

Stage Where Federal Questions were Raised

In United States v. Dubilier Condenser Corp., 289 U.S. 178 (1933), which involved a patent granted under Art. I, § 8, cl. 8 of the United States Constitution, this Court held that a patent is a property right. Accordingly, as a property right protected by the Fourteenth Amendment of the Constitution, a patent cannot be taken away without due process of law.

In the present case, petitioners argued in the trial court that the holding of United States v. Dubilier Condenser Corp. was the controlling law.

In their trial brief, petitioners raised this issue:

> "If an employee has a general employment agreement and has not been hired specifically to make inventions, any invention made by the employee during his period of employment remains his personal property. In the absence of an

> express agreement to assign inventions, the courts will not imply or infer an agreement by an employee to assign his patent to the employer. If the employee makes the invention on the time, money and materials of his employer, the most to which the employer is entitled is a shopright which is a nonexclusive right to practice the invention but ownership of the invention remains in the employee. United States v. Dubilier Condenser Corp., 289 U.S. 178, 77 L.Ed. 1114 (1933)." Defendants' Trial Brief at page 9.

Petitioners also raised this issue in their post trial memorandum:

> "The definitive case relating to patent rights as between an employer and employee in an employee-made invention is the U.S. Supreme Court decision in United States v. Dubilier Condenser Corp., 289 U.S. 178, 77 L.Ed. 1114 (1933). Although the case involved an employee of the U.S. Government, the Court made it clear that the law is the same for a private employer." Defendants' Post Trial Memorandum at page 6.

In the Oregon Court of Appeals, petitioners contended that this Court's decision in Dubilier governs the facts in the case. Cross-appellants' brief.

In the Oregon Supreme Court, petitioners stated:

> "The Court of Appeals misapplied the law of master-servant as enunciated by the United States Supreme Court in the seminal case of United States v. Dubilier Condenser Corp., 289 U.S. 178 (1933). Petition for review of Timberland Machines and Engineering Corp., E. H. Swafford, and F. L. Miller."

REASONS FOR GRANTING THE WRIT

1. THE DECISION BELOW CONFLICTS WITH THIS COURT'S DECISION IN UNITED STATES V. DUBILIER CONDENSER CORP., SUPRA.

In determining entitlement to an invention as between an employer and an employee, absent an employment contract, title to the invention of an employee is governed by the traditional common law of master-servant. The standards set forth by this Court in United States v. Dubilier Condenser Corp., supra,

remain the touchstone for determining such disputes. As cogently synopsized in Dubilier:

> "One employed to make an invention, who succeeds, during his term of service, in accomplishing that task, is bound to assign to his employer any patent obtained. The reason is that he has only produced that which he was employed to invent. His invention is the precise subject of the contract of employment. A term of the agreement necessarily is that what he is paid to produce belongs to his pay-master. Standard Parts Co. v. Peck, 264 U.S. 52, 68 L.Ed. 560, 44 S.Ct. 239, 32 A.L.R. 1033. On the other hand, if the employment be general, albeit it covers a field of labor and effort in the performance of which the employee conceived the invention for which he obtained a patent, the contract is not so broadly construed as to require an assignment of the patent. Hapgood v. Hewitt, 119 U.S. 226, 30 L.Ed. 369, 7 S.Ct. 193; Dalzell v. Dueber Watch Case Mfg. Co., 149 U.S. 315, 37 L.Ed. 749, 13 S.Ct. 886. In the latter case it was said:
>
> > 'But a manufacturing corporation, which has employed a skilled workman, for a stated compensation, to take charge of its works, and to devote his time and services to devising and making improve-

> ments in articles there manufactured, is not entitled to a conveyance of patents obtained for inventions made by him while so employed, in the absence of express agreement to that effect.'
>
> The reluctance of courts to imply or infer an agreement by the employee to assign his patent is due to a recognition of the peculiar nature of the act of invention . . ." 289 U.S. at 187-188.

As demonstrated by Dubilier and its progeny, courts are very reluctant to impress upon an employee a duty under the common law to assign his or her patent.[5] In essence, a presumption

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[5] Melin v. United States, 478 F.2d 1210, supra (Ct. Cl. 1973); Ushakoff v. United States, 327 F.2d 669, supra (Ct. Cl. 1964); Logus Mfg. Corp. v. Nelson, 195 U.S.P.Q. 566 (E.D.N.Y.), aff'd on rehearing, 200 U.S.P.Q. 570 (E.D.N.Y. 1977); Chilton v. Comr. Internal Revenue, 40 T.C. 552, 138 U.S.P.Q. 336 (1963); Bandag, Inc. v. Morenings, 146 N.W.2d 916, supra; Cambridge Wire Cloth Co. v. Applegarth, 141 U.S.P.Q. 44 (Md. Cir.Ct. 1964); Mosser Industries, Inc. v. Hagar, 200 U.S.P.Q. 608 (Pn. Ct. C. Pleas. 1978); see Deller's Walker on Patents, 2d ed., vol. 4, § 378.

arises in favor of the employee retaining ownership of the patent absent clear proof by the employer to the contrary.

Inquiry must be focused on (1) whether there is an oral or written contract of employment governing rights to inventions; and, if there is no contract of employment, (2) whether the employee was hired in a general capacity or hired specifically to invent.

As enunciated in Dubilier, if the employee was employed in a general capacity, the employee is not required to assign any patents obtained on his or her inventions even though the subject of the patent relates to his or her field of employment. Conversely, if an employee was hired specifically to invent, the employee is required to

assign to the employer any patents obtained on inventions relating to the employer's product line.

In the courts below, petitioners contended that an oral contract existed between Miller and his original employer, CM&E, which provided that Miller was entitled to retain ownership of all patents obtained by him using his own time, money and facilities. Petitioners alternatively maintained that, absent such a contract, because Miller was employed in a general capacity, he was entitled under Dubilier to retain ownership of the 1978 knifeholder patent.

Turning to the facts in the present case, Alfred Maede founded CM&E in 1953. Shortly thereafter, Maede asked petitioner Frederick L. Miller, an old college friend of Maede's, to go to work for him. Edmond Gurney joined CM&E at about

the same time and initially the three of them (Maede, Miller and Gurney) were the only employees.

Miller testified that prior to accepting employment with CM&E, he explained to Maede that due to his established practice of making inventions, searching their patentability and obtaining patents, he did not want to be employed by anyone who would place any restriction on these activities. Tr. 350-51. He further testified:

> "We agreed that anything that I invented on my own time, including my own materials and other facilities, would be my property alone. And following that, anything that I did in the office that was done with company time and materials, would be assigned normally to the company." Tr. 351.

Based on that agreement, Miller maintained an outside engineering consulting practice which was well-known to CM&E during the entire period of time Miller

worked for CM&E. Tr. 352-53 and 730. While employed, Miller obtained six patents on various inventions. Three were assigned to his employer and three were retained by Miller. All patents related to CM&E's business. Tr. 328-30; exhibits 30, 153, 154, 155, 188 and 190.

The existence of the Miller-CM&E agreement was also attested to by three impartial witnesses: Edmond Gurney, a CM&E employee from 1955 to 1975 and former president of the corporation; Harold Elford, a private business person who, at Maede's suggestion, consulted Miller regarding an engineering problem; and Lee Schermerhorn, Miller's patent attorney from the late 1940's or early 1950's and CM&E's patent attorney from the late 1950's or early 1960's. Tr. 684-87, 715-20, 730, and 734-37.

During his employment, Miller's duties included engineering, sales, inspection of equipment that was manufactured, shop problems regarding drawing or manufacturing errors, all incidental troubleshooting, field installations, servicing equipment and training field and mill personnel to operate and troubleshoot the equipment. Tr. 139, 197, 349-50, 467, and 587.

The Court of Appeals concluded that Miller had an implied duty to assign to CM&E any patents which directly related to CM&E's product line. Based on this holding, Miller was ordered to assign the 1978 knifeholder patent to respondent. A basic problem with the Court of Appeals' decision is that it hopelessly intermingled in its analysis the issue of "whether Miller had an implied duty to assign patents under the principles

set forth in Dubilier" with the issue of "whether in this particular case an express oral contract existed between Miller and his original employer governing rights to the patent".

Although it has been petitioners' position that the Miller-CM&E agreement is determinative of all rights to the 1978 patent, under Dubilier it is plain that Miller has no implied duty to assign his invention to respondent. As set forth by this Court in Dubilier, where an employee is hired in a general capacity there is no duty to assign title to any inventions conceived by the employee absent a clear agreement to that effect. Furthermore, in the case of general employment, an employee has no implied duty to assign an invention even though it relates to the employer's product line.

> "'[A] manufacturing corporation, which has employed a skilled workman, for a stated compensation, to take charge of its works, and to devote his time and services to devising and making improvements in articles there manufactured, is not entitled to a conveyance of patents obtained for inventions made by him while so employed, in the absence of express agreement to that effect." United States v. Dubilier Condenser Corp., 289 U.S. at 187-88 (citing Dalzell v. Dueber Watch Case Mfg. Co., 149 U.S. 315 (1893).

Thus, it is plain from Dubilier and its progeny that employed inventors are a favored class which courts seek to protect by carefully circumscribing the instances in which an employed inventor must assign to the employer title to any patents obtained on inventions.

In the case at bar, the Court of Appeals on the first page of its opinion stated that Miller's duties included: "inventing, designing, developing and engineering products and improving Mainland's product line"; that he also

Appeals held that Miller was required to assign his patent to respondent.

Although respondent has stressed that Miller was supposed to solve problems relating to respondent's equipment and that the 1978 knifeholder solved problems connected with the 1973 knifeholder, at the time Miller made his invention in 1975 there were no particular problems with the 1973 knifeholder. Tr. 697. Rather, the evidence shows that the alleged problems occurred after Miller had conceived of his invention. Edmond Gurney, president of CM&E from 1973 to 1975, did not recall any problem regarding plugging or jamming of the 1973 knifeholder. He believed that such a problem would have been brought to his attention because he generally fielded customer complaints. Tr. 720. Moreover, Gene Hill, CM&E/Mainland's manager,

testified that he was unaware of any problems with the 1973 knifeholder until 1979. Tr. 31 and 63-65. From out of its 400 to 500 chipping heads on the market which employed over 3,000 knifeholders (8 knifeholders per machine), CM&E/Mainland made two service calls to correct alleged plugging problems with the 1973 knifeholder. Tr. 446-47. In both instances, the equipment was being misused by the customer. Tr. 279, 282, 364, 383, 398-99, and 415.

It is also important to note that although respondent's manager had assigned Miller the duties of designing a waste wood chipper and a saw edger, he never asked Miller to design or to invent an improved knifeholder. Tr. 74-75. Even by the time of trial respondent had not assigned this task to an employee. Tr. 75.

Petitioners submit that the proper framework for analysis is that provided by this Court in Dubilier. Under such a framework, it is apparent that Miller was not specifically hired to invent, rather his duties were general in nature. Consequently, Miller had no duty to assign to respondent the 1978 patent on his invention.

2. THE COURT HAS NOT FOR FIFTY YEARS PASSED ON THE QUESTION OF OWNERSHIP OF INVENTIONS BY EMPLOYED PERSONS.

During the past fifty years, the question of ownership of inventions as between employer-employee has become very important in our ever expanding technical society where inventing is to a great extent performed by corporate employees. Specific German and Swedish laws cover compensation for employed inventors. At least one bill was introduced in Congress

to "create a comprehensive federal system for determining the ownership of and amount of compensation to be paid for inventions and proposals for technical improvements made by employed persons" and suggestions have been made for similar state legislation.[8]

Since the Court's 1933 decision in Dubilier it has not addressed that important question. The time would appear to be ripe for additional guidance to the lower courts and a reaffirmation of Dubilier.

CONCLUSION

Based upon the foregoing facts and law, petitioners request that a writ of certiorari issue to review the judgment and opinion of the Court of Appeals.

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[8]"The Law of the Employed Inventor - Time for a Change?", 57 Mass. L.Q. 27, 37 (1972).

Dated this 28th day of January, 1983.

Respectfully submitted,

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APPENDIX

IN THE COURT OF APPEALS
OF THE STATE OF OREGON

MAINLAND INDUSTRIES, INC., Appellant - Cross-Respondent,	)	
	)	No. 78-6-90
v.	)	CA 19614
TIMBERLAND MACHINES AND ENGINEERING CORPORATION, et al, Respondents - Cross-Appellants.	)	

[August 18, 1982]

Appeal from Circuit Court, Clackamas County.

VAN HOOMISSEN, J.

Plaintiff Mainland Industries, Inc. (Mainland) appeals from a trial court decree that (1) ordered defendant Miller to assign a patent to Mainland, but allowed Miller a lifetime license in the patent, and (2) denied Mainland's prayer that a constructive trust be imposed on any profits earned by defendants as a result of their wrongful

use of the disputed patent. Defendants cross-appeal, contending that the trial court erred in holding that Mainland owns the patent and in holding that certain documents in defendants' possession belong to Mainland. We review de novo.

Mainland manufactures sawmill equipment. Defendant Miller was an employe of Mainland or of its predecessor company, Chipper Machines and Engineering Corp. (CM & E), from 1953 until 1978.[1] As Mainland's chief engineer, Miller was in charge of the firm's engineering department. His duties included inventing, designing, developing and engineering products and improving Mainland's product line.[2] He also served as Mainland's chief troubleshooter, solving problems and handling customer complaints. When something

went wrong, it was his responsibility to assign the work to another engineering department employe or to solve the problem himself.

The type of knife used in Mainland's product line is crucial. Miller realized that Mainland's headrig slabber would work better if its slotted knife could be eliminated. In the early 1970s, he bagan working on a new design. That effort led to a 1973 patent, which belongs to Mainland and is not in issue here. While the 1973 patent had the advantage of doubling knife life, users complained about the knife holder. Rather than assigning the problem, Miller handled it himself. He conceived a solution in 1976. [3]By changing the clamping mechanism, he designed a device that used an unslotted knife and that substantially eliminated the knife

holder problem. The new design also simplified production, reduced costs and made service easier. Miller did not disclose his new design to his employer.

In late 1976 and early 1977, after Miller had conceived of the new design, Mainland received more complaints about its 1973 knife holder. When a customer in British Columbia reported problems, Miller went there to investigate. After a meeting with management, he reported that "no known solution" to the problem existed. In 1977, Miller filed an application for a patent on his new design, and a patent was granted in 1978. Because Mainland was unaware of the new design, it continued to replace its 1973 knife holders with an older model using slotted knives. The older model reduced some customer complaints, but at the expense of shorter knife life.

Miller retired from Mainland about two months prior to the issuance of the 1978 patent. He immediately began working for defendant Timberland Machines & Engineering Corporation (TM & E), a company that he and defendant Swafford, Mainland's former chief accounting officer, organized to manufacture and sell products that compete with Mainland's product line. Shortly after Miller began working for TM & E, one of Mainland's customers purchased a 1978 knife holder from TM & E as a replacement for one of Mainland's 1973 knife holders. That customer had experienced problems with the 1973 holder and believed that TM & E's 1978 design would solve those problems.

The 1978 Patent

The first question is whether the trial court properly awarded the 1978

patent to Mainland. Absent an agreement to the contrary, when an employe is hired to invent, or is assigned the responsibility for solving a particular problem, any resulting invention belongs to the employer.[4] When the employment relationship is general, an employe is entitled to retain any patent he procures, even though the patent relates to the employer's product line. U. S. v. Dubilier Condenser Corp., 289 US 178, 187, 53 S Ct 554, 77 L Ed 1114 (1933); Standard Parts Co. v. Peck, 264 US 52, 58-59, 44 S Ct 239, 68 L Ed 560 (1924); Solomons v. United States, 137 US 342, 346, 11 S Ct 88, 34 L Ed 667 (1890); see Blum v. Commissioner of Internal Revenue, 183 F2d 281, 287 (3rd Cir 1950); Marshall v. Colgate-Palmolive-Peet Co., 175 F2d 215, 217, 81 PQ 517 (3rd Cir 1949); Daniel Orifice Fitting

Co. v. Whalen, 198 Cal App 2d 791, 797-98, 18 Cal Rptr 659 (1962); see also Restatement (Second) of Agency, § 397 (1958).

Defendants contend that Miller and Alfred Maede, CM & E's founder, entered into an express oral agreement under which Miller is entitled to the patent. At trial, Miller testified that before he consented to work for CM & E, Maede agreed

> "[t]hat anything that I invented on my own time, including my own materials and other facilities, would be my property alone. And following that, anything that I did in the office that was done with company time and materials, would be assigned normally to the company."

The testimony of Edmond Gurney, CM & E's former president, tended to corroborate Miller's testimony regarding the existence of some sort of an agreement. The existence of some agreement

was also substantiated by Elford, who had received independent engineering assistance from Miller at Maede's suggestion. Schermerhorn, Mainland's patent attorney, testified that it was

> "[his] understanding that the patents that belonged to CM & E were those that were made on company time and at the company expense. And that any work that Fred Miller did outside of company time and at his own expense would be his own patent."

Apparently discounting the testimony of Gurney, Elford and Schermerhorn, the trial court found that "The only evidence that such an agreement ever existed is Miller's word." The court concluded that no such agreement existed and that Miller's practice of assigning other patents related to the company's business to the company belied the existence of such an agreement. The trial court also found:

of a duty to assign. See Perkins v. Standard Oil Co., 235 Or 7, 15, 383 P2d 107, 383 P2d 1002 (1963) (course of conduct pursued by parties to contract over course of years is reliable evidence of parties' intent); see also Fish v. Air-O-Fan Products Corporation, 285 F2d 208, 210, 128 PQ 4 (9th Cir 1960); Marshall v. Colgate-Palmolive-Peet Co., supra, 175 F2d at 217-18; E. F. Drew & Co. v. Reinhard, 170 F2d 679, 683, 79 PQ 252 (2d Cir 1948); Daniel Orifice Fitting Co. v. Whalen, supra, 198 Cal App 2d at 797-98.

Miller was not able to recall where he was or when he conceived of the ideas for his new design, but it seemed likely to him that he thought about it at work. Miller was a salaried employe. He did not work specific hours. It was his practice to work evenings, both at

and away from his employer's premises. Arguably, he developed his new design at home. However, the place where an invention is developed is not determinative of whether the employer or the employe is entitled to a patent. Under similar facts, the court stated in Daniel Orifice Fitting Co. v. Whalen, supra:

> "* * * * It is difficult to understand how [the employe] could cut his mind off and on at will under the circumstances, i.e., think of things during the lunch hour, for example, which would constitute an improvement to plaintiff's product, and later claim such improvement as his own because he was not working for the company at that particular moment when the thought struck him* * * *" 198 Cal App at 798.

See Crown Cork & Seal Co. v. Fankhanel, 49 F Supp 611, 57 PQ 518 (D Md 1943); National Development Co. v. Gray, 316 Mass 240, 55 NE 2d 783, 788, 153 ALR 973 (1944); Parker Rust-Proof Co. v. Allen, 231 Mich 69, 203 NW 890 (1925).

Miller conceded that he often worked on office projects at home. Mainland's other engineering employes did the same. Miller testified that, almost without exception, he was the only employe who worked with Mainland's patent attorney. He admitted that the 1973 patent idea probably came to him at home. Yet, there was no question in his mind but that the 1973 patent belonged to Mainland. In many respects the 1978 design incorporated the same features as the 1973 design. How Miller could concede that Mainland was entitled to the 1973 patent, yet contend that the company was not entitled to the 1978 patent, is difficult to understand.

Defendants appear to contend that it was within Miller's sole discretion to determine whether any invention he created would belong to Mainland or to

himself. In Perkins v. Standard Oil Co., supra, 235 Or at 16, the Supreme Court quoted with approval the words of Justice Cardozo in Moran v. Standard Oil Co., 211 NY 187, 105 NE 217 (1914): "An invention to make so one-sided an agreement is not readily to be inferred." In view of the conflicting evidence concerning Miller's agreement with Maede, we cannot reasonably conclude that Maede would have put CM & E at the mercy of Miller in the manner defendants suggest. See 3 Corbin on Contracts 278-79 (1960). The testimony of CM & E's former president, Gurney, persuades us that, although Miller may have been entitled to patents on ideas that were unrelated to Mainland's product line, he was not entitled to patents directly related to his employer's product line. We conclude that the parties intended

that Miller would assign to Mainland any patents directly related to his employer's product line. Without question, the 1978 patent was directly related to Mainland's product line.

When, as here, the evidence is both conflicting and confusing and the credibility of some of the witnesses is in issue, we accord considerable weight to the conclusions of the trial court, even though we do review de novo. Dan Bunn, Inc., v. Brown, 285 Or 131, 145, 590 P2d 209 (1979). We agree with the conclusions reached by the trial court on the patent question. The trial court properly awarded the patent to Mainland.

The Miller License

Mainland contends the trial court erred in awarding Miller a lifetime license in the patent. The court explained:

> "* * * * This is done because Miller, had he have been truly larcenous, could have handled the matter with more cunning and probably have succeeded. What a man carries away in his mind from a former position of employment is usually his unless there is a signed covenant not to compete for a specific (relatively short) duration. * * * Miller wanted the patent for his own. He just went about it in the wrong way. * * * This Court is not saying Miller's actions were not wrong. However, had he handled it differently, ownership might be his and it is only equitable in that light that Miller enjoy some of the fruits of his labor and recover something for his diligence in spending weekends and evenings reducing the idea to a tangible form and for paying for the expense of copyrighting it."

Defendants argue that the license was properly granted under equitable principles embodied in the "shop-right" doctrine. Under that doctrine, an employer is granted a non-assignable license to a patent when an employe who works in a general or non-inventive capacity creates an invention using the employer's time and materials. See

U. S. v. Dubilier Condenser Corp., supra, 289 US at 188-89. The rationale for the rule is that because the patent resulted from use of the employer's property and from labor for which the employe was paid by his employer, it is equitable that the employer share in the invention. Defendants concede that no precedent exists for applying the "shop-right" doctrine in favor of an employe. Moreover, the facts here do not warrant application of the doctrine. As Mainland's chief engineer, Miller's duties included solving problems in the use of his employer's products. If a solution was possible, it was his duty to find it. Having already received a substantial salary from Mainland to invent, design and develop products and improvements, Miller now has no equitable claim to a license.[5]

An equity court has broad power to fashion an appropriate remedy. However, the court's discretion is not absolute, and it must be exercised within bounds of sound legal and equitable principles. Ellison v. Watson, 53 Or App 923, 930-31, 633 P2d 840, rev den 292 Or 109 (1981); Shumate v. Robinson, 52 Or App 199, 205, 627 P2d 1295 (1981).

In deciding whether Miller properly was awarded a license, we are also mindful of the maxims that equity will not aid a wrongdoer and that a party seeking equity must have clean hands. See North Pacific Lumber Co. v. Oliver, 286 Or 639, 650-53, 596 P2d 931 (1979). The trial court found that Miller had pursued a secret course of action in obtaining the 1978 patent. The court also found that:

> " * * * Miller did not invent the '78 patent just for fun. The

> evidence indicates very strongly that at the time the '78 patent was formulated it was intended as a replacement part for CM&E's then existing line of products. This combined with Miller's and Swafford's taking of documents not rightfully theirs adds up to bad faith and unclean hands and this Court cannot condone such activities."

We agree with that assessment. Miller's wrongdoing was directly related to his employment contract and to his employer's product line. Under the circumstances, we conclude that the trial court was not justified in granting Miller a license. See North Pacific Lumber Co. v. Oliver, supra, 286 Or at 653. That portion of the trial court's decree which awarded Miller a license in the patent is vacated.

Constructive Trust

Mainland next contends that the trial court erred in failing to impose a constructive trust upon any profits

received by defendants as a result of their wrongful use of the patent. A constructive trust is a trust created by operation of law when a person, through abuse of a fiduciary or confidental (sic) relation, or by bad faith, fraud or other unconscionable conduct, has obtained property or money which he should not, in equity and good conscience, hold and enjoy. Marston v. Myers et ux, 217 Or 498, 509, 342 P2d 1111 (1959); Shipe et al v. Hillman, 206 Or 556, 565, 292 P2d 123 (1955); Hurlbutt v. Hurlbutt, 36 Or App 721, 724, 585 P2d 724 (1978); rev den 285 Or 73 (1979); Davis v. Howard, 19 Or App 310, 313, 527 P2d 422 (1974).

The trial court ruled in favor of defendants on Mainland's claim for damages, because the court concluded that Mainland had failed to prove any damages. That ruling appears to have

missed the point. Mainland was seeking not only damages; it also was seeking to recover profits earned by defendants as a result of their wrongful use of the patent. While plaintiff's damages and defendant's profits may be interrelated, they are nonetheless distinct concepts.

Equity seeks complete relief. To be completely vindicated, Mainland is entitled to recover profits earned by defendants as a result of their wrongful use of the patent. Mainland would be deprived of what was justly its, and defendants would be unjustly enriched were they permitted to retain such profits. Substantial justice will be accomplished by preventing such unjust enrichment and by requiring restitution to Mainland of profits which in equity and good conscience did not belong to defendants. See Derenco v. Benj.

Franklin Fed. Sav. and Loan, 281 Or 533, 556-58, 577 P2d 477, cer den 439 US 1051 (1978); Duplate Corp. v. Triplex Co., 298 US 448, 450, 56 S Ct 792, 80 L Ed 1274 (1936); Leman v. Krentler-Arnold Co., 284 US 448, 455-57, 52 S Ct 238, 76 L Ed 389 (1932); Albino v. Albino, 279 Or 537, 550, 568 P2d 1344 (1977); Daniel Orifice Fitting Co. v. Whalen, supra, 198 Cal App 2d at 797 (1962) (because of the nature of the product, every sale by defendants necessarily cost plaintiff a sale); see also 76 Am Jur 2d Trusts, § 229.

Accounting

The next question is whether Mainland is entitled to an accounting. On the record here, we conclude that such further proceedings are appropriate. There is evidence in the record that

defendants earned profits as a result of their use of the patent. No suggestion has been made that any unusual difficulty would be experienced or expense incurred in arriving at an accounting for those profits. See Stephan v. Equitable S & L Assn., 268 Or 544, 576-77, 522 P2d 478 (1974) (difficulty and expense considered in denying request for accounting).

Documents

On cross-appeal, defendants contend that the trial court erred in finding that certain documents in defendants' possession belonged to Mainland. The documents were taken from Mainland's files when defendants Miller and Swafford left the company. Miller contends that he took some engineering documents primarily for sentimental reasons.[6]

Swafford contends that he took some accounting documents to defend against a possible tax suit.[7] The trial court found that the documents contained confidential and secret information.[8] But even if they did not, the documents belonged to Mainland. They were not the property of Miller of Swafford. See Midland-Ross Corporation v. Yokana, 185 F Supp 594, 604 (D NJ 1960) aff'd 293 F2d 411 (1961). The trial court correctly ordered their return.

Affirmed in part; reversed in part; that portion of the decree giving defendant Miller a license in the patent is vacated; remanded to the trial court with instructions to order an accounting of profits earned by defendants as a result of their wrongful use of the patent and to impose a constructive trust on such profits for the benefit of Mainland.

department specific projects on which to work, including inventing, designing, developing, and engineering various products, solving various problems with existing products, and improving existing products, and improving existing products.

"(d) making it possible for those companies to reduce [manu]facturing costs for products and increase profits.

"(e) working with each company's patent attorney to secure appropriate patent protection for inventions, developments, and designs of the kind set out above in subparagraphs (a) through (d) above and assigning to the companies all rights to those patents; and,

"(f) serving as an officer and director of Chipper Machines beginning in 1973 until the acquisition by plaintiff."

3

Miller testified that he had invented the knife holder in 1976 while he was employed by Mainland. Later, he testified that he had conceived the idea in 1975 while he was employed by CM & E

when he conceived the idea for the knife holder and that he was employed by Mainland "while he made modification in his original idea and when he prepared the drawings and made application for the patent."

4

The trial court found:

"Miller had a duty while employed by plaintiff and its predecessor to:

"(a) work on correcting the knifeholder if there were complaints about its efficiency or operation or to improve its performance.

"(b) devote the time required to a project if a patent was within reasonable contemplation.

"(c) assign work for improving the knifeholder to other trusted persons in his department if he did not have the time to do it himself.

"(d) follow up on (c) and see that the problems were solved.

"(d) disclose all ideas to his employer that were relevant to its products.

"(e) not work secretly in competition with his employer and

"(f) assign the patent on the 1978 knifeholder to plaintiff."

5

Defendants rely on Taylor v. Berkheimers, Inc., 48 Or App 901, 618 P2d 452, rev den 290 Or 271 (1980), for the proposition that, even though Miller may have acted wrongfully in appropriating the patent, he was not precluded from equitable relief. Taylor, however, is inapposite. There, we held that a corporate officer who had breached a fiduciary duty did not forfeit all rights to compensation for services rendered to his employer. Compensation is not an issue here.

6

The trial court found:

"When Miller left plaintiff's employ, he took with him engineering records owned by plaintiff. The

documents contain information not generally known to plaintiff's competitors which gives plaintiff an advantage over those competitors who do not know the information. Information contained in the documents was developed at great expense to plaintiff and its predecessor. The document would be very useful to anyone attempting to duplicate plaintiff's products or to compete with plaintiff, particularly defendants. The documents also contain information that plaintiff needs to operate its business. * * *"

7

The trial court found:

"When defendant Swafford left plaintiff's employ, he also took financial and accounting records owned by plaintiff. These documents contain financial and cost information not generally known to plaintiff's competitors which gives plaintiff an advantage over those competitors who do not know or use it. Information contained in the documents was developed at great expense to plaintiff. The documents would be very useful to anyone attempting to duplicate plaintiff's products or to compete with plaintiff, particularly defendants. * * *"

8

In Prentice Dryer v. Northwest Dryer, 246 Or 78, 424 P2d 227 (1967), cited by defendants, the alleged trade secrets were well known by competitors. 246 Or at 81-82.

IN THE CIRCUIT COURT OF THE STATE OF OREGON

FOR THE COUNTY OF CLACKAMAS

MAINLAND INDUSTRIES, INC. a Delaware corporation, Plaintiff, vs. TIMBERLAND MACHINES AND ENGINEERING CORPORATION, an Oregon corporation, E. H. SWAFFORD, F. L. MILLER and JOHN DOES 1 through 20, Defendants.	No.78-6-90 MEMORANDUM OPINION

The plaintiff's complaint is too full of redundancy and indirect complaints to be set out by paragraphs. Boiled down to understandable and succinct issues, its 13 pages may be summarized by saying Miller, a trusted chief engineer and Swafford, a trusted finance officer are both ex-employees of plaintiff, who, when they left their employment with plaintiff, each took confidential work products belonging to plaintiff. Swafford then set up a company that competes with plaintiff

not only in name (TM&E vs. CM&E) but in machinery furnished to the sawmill industry. That shortly after TM&E was organized, Miller retired from CM&E (Mainland) after having served on its Board of Directors and was its chief engineer and then joined Swafford at TM&E. That immmediately TM&E began competitive bidding with CM&E (Mainland) and could only do this because of the drawings, cost estimates and secrets Swafford and Miller purloined from CM&E, and which invclve several yeras to develop. Plaintiff asks for the return of all documents, drawings, estimates, inventions, etc., from Swafford and Miller. In a separate cause of action plaintiff asks for general and punitive damages and in a separate cause of suit, ask that any sales by TM&E be held in trust for plaintiff, because of the purloined documents.

Defendants answered, denying all accusations of misconduct, counter claiming

for damages and further alleging plaintiff has unclean hands and not entitled to equitable relief. Plaintiff replied and dstated among other things defendants have unclean hands.

Defendants prepared and filed a request for special findings of fact.

It appears to me there are two main issues, 1) who owns the 1978 knife holder patent and 2) are defendants required to return the "documents" they took with them when each left plaintiff's employment.

The answer to these questions premarily rest on an interpretation of the relationship of Fred Miller with plaintiff. E. H. Swafford was a finance officer with plaintiff and the law as it pertains to F. L.Miller, equally applies to Swafford. Because of the length of service of Miller, the scope of his dutiesand obligations, the specificity of plaintiff's request

i.e. patent, this inquiry will focus on Miller.

Fred Miller was not an ordinary person employed in a general capacity. He had special skills and was designated chief engineer. He had business acumen and served on the Board of Directors of CM&E. He was their "Chief" salesperson in the earlier times with CM&E, became acquainted with persons who needed their equipment and was a trouble shooter. When a mill had a problem, they would send for Fred Miller to solve it. He was an inventor holding approximately 73 patents and assigning the last one prior to the '78 patent to the Company. He was highly respected as an engineer by his contemporaries and praise was lavished upon him in court.

He was a close business and social friend of Meady (sic), former owner of CM&E. Miller claimed he had an under-

standing with Meady (sic) that he could own or keep anything he invented. There was no other evidence of such an agreement. Further, such an agreement is contrary to the Oregon Administrative Rule (OAR) 820-20-005(5)(a) and (b) as well as the National Society of Professional Engineers Code of Ethics § 9 (language from both sources set out later). As will be discussed later, Miller was not hired specifically solely to invent. He was their Chief Engineer, hired to design, develop, test machines and correct problems. It is easily argued by plaintiff that these duties included "inventing" if the design, development or corrective measure was economically patenable (sic).

DISCUSSION

(Law and Facts)

(Whenever underlining of language appears, and it does liberally, it is

mine.)

Patent law is intended to protect the inventor from the misappropriation of his ideas, promote creative thinking, and encourage technological progress. This is accomplished, unless there is an agreement or a duty to assign, by granting sole proprietary interest in a novel idea to its originator. A duty to assign can arrive via an express agreement (as a condition, implication, or expection of employment) or as a result of a special duty such as a fiduciary or trustee relationship.

The accepted general rule regarding patent ownership is derived from the holdings in Hapgood v. Hewitt, 119 US 226, 7 S.Ct. 193 (1886), Dalzell, et al v. Dueber Watchcase Mfg. Co. 149 US 315, 13 S.Ct. 886 1893), and U.S. v. Dubilier Condensor Corp. 289 US 188, 53 S.Ct. 577 (1933).

The limitation or exception to

the general rule is spawned from the holdings in Solomons v. U.S., 137 US 342, 346, 11 S.Ct. 88, 89 (1890), and Standard Parks v. Peck, 264 US 52, 445 Ct. 239 (sic, 44 S.Ct. 239) (1924). Many states have had the opportunity to rule on these provisions of law with the holdings, on close inspection, being fairly consistant (sic). A recent California case Logus Mfg. Corp. v. Nelson, 195 USPQ 566, 567 (1977) perhaps best summarizes the current status of patent law ownership.

> "If an employee is hired to invent or is given the task of devoting his efforts to a particular problem, the resulting invention is the employer's, and any patent obtained by the employee must be assigned to the other. See Standard Parts Co. v. Peck, 264 US 52.44 S.Ct. 239 *** Marshall v. Colgate-Palmolive Peet Co. (3 Cir) 175 F2d 215, 217, 81 USPQ 517, 518. On the other hand an employee whose employment is 'general' is entitled to retain any patent which he procures and need not assign it to his employer, even though his employment covers a field of labor and effort in the performance of which the employee conceived the invention for which he obtained a patent." United States

v. Dubilier Condensor Corp., 289 U.S. 178, 187, 53 S.Ct. 554, 557, 17 USPQ 154, 157-158; *** see, also Dalzell v. Dueber Watch-Case Mfg. Co., 149 US 315, 320. 13 S.Ct. 886, *** Houghton v United States 4 Cir 23 P2d 386; see also Toulmin Handbook of Patents (2d ed. 1954) p. 130. Indeed even where an employee is hired to devote his time and services to devising and making improvements in articles *** manufactured" in his place of employment, he is entitled to enjoy the fruits of any invention which he conceives while so employed and is under no duty to turn the patent obtained over to the employer 'in the absence of an express agreement to that effect. Dalzell v Dueber Watch-case Mfg. Co. (Supra) ... and (others.")

Plaintiff contends and this court finds that part of Miller's duties included "devoting his efforts to a particular problem", or need of the company, as the circumstances at any given time required, and effecting a solution. Thus any "resulting invention" should belong to the employer --CM&E (Mainland). Defendant maintains, and this court does not so find, that his employment was general. That he was not specifically (sic) to invent and that

here was an express oral agreement allowing Miller to keep for himself that which he did on his own time and expense. This court must point out that specifically hired to invent does not means or require that one be solely hired to invent. The matter of on whose time the work was done and the alleged meady (sic) agreement will be taken up later.

Following Hapgood v Hewitt, the Court said "a manufacturing corporation which has employed a skilled workman, for a stated compensation, to take charge of its works, and to devote his time and service to devising and making improvements in articles there manufactured, is not entitled to a conveyance of patents obtained for inventories made by him while so employed, in the absence of express agreement to that effect." Dalzell v. Dueber.

Solomons v U.S. agreed with but restricted the above principle saying,

to his employer, since in making such improvements he is doing what he was hired to do." The court in dicta said "It cannot be contended that the invention of a specific thing cannct be made the subject of a bargain and pass in execution of it. And such we think, was the object and effect of defendant's contract with plaintiff." The court further said ... [plaintiff] "had a want in its business- a problem...and...thought...that defendant could be of some assistance in working out the problem, and the thought was natural."

U.S. v. Dubilier Condenser Corp., (supra) held "A patent is property, and title to it can pass on by assignment... The representative rights and obligation of employer and employee, touching an invention conceived by the latter, spring from the contract of employment.." Following Standard Parts the court further held "a term of agreement nencessary is that which

he is paid to produce belongs to the paymaster." The court again cited Dalzell, for the proposition that general employment required an express agreement to create a duty to assign.

Clearly these cases stand for the proposition that ownership is predicated upon the existence of certain circumstances, and expectations of employment and in their absence an express agreement to assign. The question is: Was the employee, in making his discovery, doing what he was paid to do or was it the byproduct of his general employment. The answer is found by looking at the relationship between the parties and the circumstances surrounding the inventor's employment responsibilities, obligations, and expectations.

The employee's acceptance of employment may act, under proper circumstances, as an implied agreement to assign. Relying on Solomons v. U.S., (Supra), the

3rd circuit held that [in a case] "where the patentee is employed specifically to invent or devise the particular improvement in question...an express contract to assign the patent may...be inferred from the acceptance by the employee of the specific employment." Pressed Steel Car Co. v. Hanson, 137 F 403, 414-415(1905).

Houston v. U.S., 23 F2d 386, 389 (4th 1928), cert denied 277 US 592, 48 S Ct 528, folloiwng the reasoning of Standard Parts and Solomon in holding"... if one did merely that which he was being paid to do...there can be no doubt that his invention is the property of his employer." Note there is no mention of one being paid exclusively to invent, only that what was invented was the product abd result of what one was paid to do. Such is the case with Miller's discovery of the 1978 patent. As Chief Engineer, he was being paid to either assign to his staff or implement

himself solutions to problems with CM&E equipment. The 1978 patent and its discovery were a resulting product of Millers employment with CM&E.

The Houghton court, in countering an argument similar to Miller's that defendant was not employed specifically as an inventor or to discovery the subject of the patent, said (at 390):

> "The trouble with this argument is that it gives too narrow a meaning to the word "employed". The right of the employer to the invention or discovery of the employee depends, not upon the terms of the original contract of hiring, but upon the nature of the service in which the employee is engaged at the time he makes the discovery or invention, and arises, not out of the terms of the contract of hiring, but out of the duty which the the employee owes to his employer with respect to the service in which he is engaged. It matters not in what capacity the employee may originally have been hired, if he be set to experimenting with the view of making an invention and accepts pay for such work, it is his duty to disclose to his employer what he discovers in making the experiments, and what he accomplishes by the experiments belongs to the employer. During the period that he

> is so engaged, he is 'employed to invent,' and the result of his efforts at invention belong to his employer in the same way as would the the product of his efforts in any other direction.
>
> "The broad principle is now laid down by the Supreme Court, too clearly to be misunderstood, that, when an employee employee merely does what he is hired to do, his successes, as well as failures, belong to his employer. Nor can it be said that one who willingly carried out the orders of his employer is not engaged upon that which he is employed to do. An employee, who undertakes upon the direction of his employer to solve a specific problem within the scope of his general employment, is as truly employed and paid for the particular project as if it had been described at the outset in the contract of employment."

Our own 9th Circuit Court rejected Hapgood as controlling and gave an invention to the employer when "defendant's regular duties included the design and development of machines for his employer ... More conclusive, it is not denied by [defendant] that he made other inventive contributions ... and assigned them to [plaintiff]." Fish v. Air-O-Fan Prod. Corp.,

285 F2d 208, 210 (1960.) Note again the absence of employment solely to invent and that the court took notice of other inventive contributions but did not require that all other inventive contributions by (sic) assigned in order for them to be significant.

Learned Hand in E. F. Drew & Co., Inc. v. Reinhard, 170 F 2d 679, 682 stated "...nor need the contract be express any more than any other contract; as the Restatement of Agency well puts it: 'For the employer to be entitled to a patent it is not necessary that the contract should specifically so provide.' It is a question to be decided upon all the facts of an individual case. In short, such a contract may be implied from the relations of the parties." Some of the facts the Drew court considered in looking at "all the facts" were how close the invention was to the principle business, loss of competitive

advantage, the intent of the parties, and the principles of good faith. Miller's position of keeping what he chose to work on outside of what he chose to consider the extent of his work day cannot be supported in light of what the knife holder means to CM&E and the loss of the competitive advantage of CM&E has long enjoyed. That Meady might allow inventions to closely related and each importance to his business and reputation as a leader in the field is beyond the intention of the employment contract. No business would intend to leave itself so poorly protected.

Invention ownership as it relates to employment is clarified in Crown Cork & Seal Co. v. Fankhanel, 49 F Supp, 611, 615 (1943) "...an invention made incidentally by an employee in the course of his regular or general employment .. is the property of the employee ... unless he has agreed either expressly or impliedly by virtue of

some special terms of his employment to transfer ownership to his employer ..." This court also noted that in Dubilier the defendants "made discoveries concerning a subject not within their assignment and not even under investigation by the ...section in which they were employed (617). Miller as chief engineer made the assignments to his staff in accordance with the needs of his employer. His duties as chief engineer satisfied any special term of employment requirement as they place Miller above general employment and make his discoveries more than merely incidental to his employment. A better knife holder or curative solution was under investigation by CM&E. The '73 patent was having problems plugging. Using the '68 patent cured the problem but eliminated using unslotted knives which have a longer service life and are more cost efficient. The '78 patent cures the

plugging problem and maintains use of unslotted knives -- the very answer CM&E needed when they sent Miller to Canada. Miller's position would have CM&E revert back to the '68 patent and step backward technologically when a step forward was within his contemplation and indeed was reduced to a tangible form prior to his termination with CM&E.

Miller equivocated that the 1978 patent may be an improvement and that there was nothing special in his discovery. This is all rebutted by the fact that a patent was allowed in the first place. 35 USC § 101 allows patents patents only for "whoever invents or discovers any <u>new and useful</u> process, machine, manufacturer, or composition of matter, or any new and useful improvement thereof ..." Miller underestimated to the court the significance of his device. He would have it that the solution was obvious and capable of

discovery by any engineer. However, the point is not just any engineer discovered it. Miller did and he did so while employed by CM&E and while being relied upon by CM&E to come up with such an answer. That a patent was even granted further indicates the solution was not so obvious "A patent may not be obtained ... if the difference between the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains" 35 USC § 103. Miller possesses extraordinary skill as witnessed by the fact that he has secured so many patents in the wood chip area. This skill is exactly what CM&E was buying when it hired Miller and made him their chief engineer and the duty to assign is further implied.

"The obligation [to assign] may arise where the employee has been assigned

the task of developing a device or process and [he] accepts that assignment." Marshall v. Colgate - Palmolive - Peet Co. 76 F Supp 378, 388, 77 SUPQ 69 (DCDel. 1948). Miller was sent (assigned) to Canada to cure the plugging problem experienced there and elsewhere with the 1973 unslotted knife holder. After careful inspection of the machine he represented he knew of no cure except substituting the 1968 slotted knife holder which was less desirable. Even after leaving Canada it was still the company's concern to develop a solution to the plugging problem with unslotted knives. This fell on Miller's shoulders as department head and by his continual employment and failure to assign it out to his staff he accepted the challenge as his own. The evidence shows, however, that Miller found the solution, kept it secret from his employer, quit his employer, and went into direct competition

with his employer featuring the very solution to the problem he said couldn't be cured. Marshall, also cited compliance of the inventor in assigning other patents (as in Miller's case) is an indication of his assent to assign.

Oregon case law on patent ownership is sparse. Our sister state to the south has had more experience and has cited Federal cases as being persuasive authority because of the experience of the federal courts in the area of patents and patent license. Farmland Irrigation Co. v. Dopplmaier, 48 Cal 2d 208, 221, 308 P.2d 732, 739 (1957).

Banner Metals, Inc. v. Lockwood, 3 Cal Rptr 421, 178 Cal App 2d 643 (2nd Dist Div 1, 1960) Follows (sic) Dubilier and at first blush seems to hold that one not specifically hired to invent could not be compelled to assign his patent. However, the court's language "The discovery of an

invention by an employee, whose duties to his employer do not require him to make any inventions during the course of his employment...does not deprive the employee of his invention" (3 Cal Rptr 428 citing Barton v Nevada Colsolidated Copper Co., 9 Cir, 71 F2d 381) would suggest a different result if the employee's duties did include some inventing. This is also consistent with the "general employment" and "incidental" to employment language and interpretations made by the U.S. Suppeme Court.

The Banner court noted that "(W)hether or not the inventions are to belong to the employer is a question to be decided upon all the facts. In granting ownership to Mainland that is exactly what this Court has done. Furthermore, "in patent cases, findings of the trial court based upon conflicting evidence (lay or expert) must be sustained unless clearly erroneous." Adamson v. Gilliland, 242 US

350, 37 SCT 169 (1917).

Two years later the same California court followed the reasoning of Solomons in determining patent ownership. Defendant had a job involving many facets of plaintiff's business such as design supervision of design, preparing and supervising drawings, liaison between suppliers and subcontractors and not just inventing. For a number of years the defendant did his job when for some reason he started "secreting" the product of his work for his own use at a later time.

> "He considered carefully the problems involved which were reported to him, and he devised improvements and modifications which would solve the particular problems but he did not apply such results and work product to his employer -- to the contrary he introduced a revised version of his employer's product and converted the benefits thereof to his own use."

Held by the Court:

> "Where a person is employed to design improvements to the product of his employer, or to design new products for his employer, and he does so, he

Miller was a key employee hired because he enjoyed high repute in the industry. His employment included the contemplation of inventions and answers to problems he was responsible for solving.

AGENCY

It is generally accepted that an agent cannot act adversely to the interests of his principal. In his capacity as chief engineer, board member, and especially field representative and trouble shooter Miller functioned as an agent of his employuer. "An agent has the duty to act solely for the benefit of his principal in all matters connected with the agency ... this duty applies to gratuitous as well as paid agents." Hughes v Helzer, ___ Or 250, 224, 185 P2d ___ (19470. [It is a] "Well settled and solutory principle that a person who undertakes to act for another shall not, in the same manner act for

himself...an agent violates his duty by secretly entering into relations or transactions concerning the subject matter of the agency in which he has interests adverse to those of his principal...These principles are well established and have been applied in a wide variety of cases." Marnon v. Vaughan Motor Co., Inc., 184 Or 103, 168-169, 194 P2d 922 (1948).

Miller had an obligation while he was employed by CM&E to act in its best interest. His position, as earlier stated, was much more than a general employee. He had the power to represent his employer's interests to other companies. In the field he could speak for the company and while in the field, as well as when at home plant he was expected to act in furtherance of the company's best interest and not in his own behalf. By keeping the '78 patent a secret and depriving CM&E of its benefits Miller attempted to better

himself at the detriment of his employer.

Phillips Screw Co. v. Givnan, et al, 200 Or 279, 283, 256 P2d 253, (1954) stands for the furtherance proposition that one in a confidential relationship is guilty of a breach of trust when he obtains a patent adverse to the interests of his employer as a result of that trust position. Miller was a trusted employee, privy to the innermost workings and secrets of CM&E. Because of his reputation and past loyalties he was above suspicion and reproach.

The testimony indicates that Miller had always previously assigned key patents. CM&E, therefore, placed in his hands the finding of solutions to their problems relying on his record to not violate any confidence or trust. Miller did exactly thta in his secretly developing solution to a problem that was assigned to him in reliance of his keeping its

magnitude and solution confidential.

The California Courts have made similar agency ruling with language very applicable to this case. Every agent owes his principal the duty of undivided loyalty. During the course of his agency he may not undertake or participate in activities adverse to the interests of his principal... corporate officers and directors are not permitted to use their positions of trust and confidence to further their private interests. While technically not trustees, they stand in a fiduciary relationship. Daniel Orfice (sic).

An agent or trusted employee is not totally prohibited from striking off on his own so long as certain conditions of good faith and openess are upheld. "Generally, directors and officers...rae not...precluded from... engaging in a business...similar to that of the corporation provided that in so doing they act in good

faith and do not interfere with the business enjoyed by the corporation...[a] party may not enter into a competing enterprise which injures a business or corporation of which he remains an officer or director... He may not seize for himself, to the detriment of his company, business opportunities in the company's line of activities... [He] may plan and develop his competative (sic) enterprise during the course of his agency only where the particular activity engaged in is not against the best interests of his principal" Sequoia Vacuum Systems v. Stronsky, 40 Cal Rptr 203, 206, 229 Cal App 2d 281 (1964).

While Miller as employed by Mainland, was no longer an officer or director of the corporation he was the Chief Engineer - a very key position with any machinery company. Furthermore, when asked to continue on with Mainland after

their acquisition of CM&E Miller indicated he assumed they would continue on as before -- that he would still be a trusted employee who would look after the company's best interests as he had done while an officer of CM&E. Mainland had nc reason to believe anything to the contrary as Miller had always been forward and open with any of his acitivites that involved CM&E. The Sequoia court elaborated on good faith and openess. "Protection of the principals interest also requires a full disclosure of acts undertaken in preparation of entering into competition" and cited defendant's covert behavior as evidence his bad faith. This position is consistant with Standard Brands, Inc., v U. S. Partition and Packaging Corp., 199 F Supp 161, 131 USPQ 288 (1961) which held that that "protection of the principal's interest requires...full disclosure... and defendants withholding of ... improvements

constitutes an actionalbe (sic) wrong." (See also Houghton P 390 - duty to disclose spelled out).

In addition to case law, disclosure is required by Oregon Administrative Rule 820-20-005(5)(a) and (b).

> "(5) Conflict of interest:
>
> (a) The Engineer or Land Surveyor shall conscientiously avoid conflict of interest with his employer or client, but when unavoidable, the Engineer or Land Surveyor shall forthwith disclose the circumstances to this employer or client.
>
> (b) The Engineer or Land Surveyor shall not accept assignment to nor compensation, financial or otherwise, from more than one party for services on the same project, or for services pertaining to the same project, unless the circumstances are fully disclosed to, and agreed to, by all interested parties."

The National Society of Professional Engineers code of ethics § 6, similar to the OAR, also requires disclosure:

> "The Engineer shall disclose all known or potential conflicts of interest to his employer or client by promptly informing them of any business connections, interests, or

other circumstances which could influence his judgment or the quality of his services, or which might reasonably be construed by others as constituting a conflict of interest."

As Miller was entrusted with the authority to make major decisions for the corporation and since he was in a position to profondly (sic) affect the success and reputation of his employer, the duty he owes cannot be less than that of an officer or director. This duty like that of an agent is higher than that owed by a general employee.

> "A public policy, existing through the years, derived from a profound knowledge of human characteristics and motives has established the rule that demands of a corporation officer or peremptorily and inexorably, the most scrupulous observance of his duty not only affirmatively to protect the interests of the corporation committed to his charge, but also refrain from doing anything that would work injury to the corporation or deprive it of profit or advantage which his skill and ability might bring to it ..." Bancroft-Whitney Corp v Glen 49 Cal R 825, 838-839, 64 Cal 2d 327, 411 P2d 921 (1966).

Miller his discovery and developing it for himself, deprived his company of the advantage his skill could have brought to it -- the skill and expertise he was hired for in the first place.

The Washington Supreme Court adopted what they termed as "Cardozo's classic definition" (Meinhard v. Salmon, 249 NY 458, 164 NE 545) of the duty owed to a corporation by a fiduciary.

> "...many forms of conduct permissible in a workaday work for those acting at arm's length, are forbidden to those bound by fiduciary ties. A trustee is held to something stricter than the morals of the market place. Not honesty alone, but the punctilio of an honor the most sensitive, is then the standard of behavior. As to this there has developed a tradition that is unbending and inveterate. Uncompromising rigidity has been the attitude of courts of equity when petitioned to undermine the rule of undivided loyalty by the 'disintegrating erosion' of particular exceptions Wendt v. Fischer, 243 NY 439, 444, 154 NE 303. Only thus has the level of conduct for fiduciaries been kept at a level higher than that trodden by the crowd. It will not consciously but lowered by any judgment of this court. Kane v. Klos, 50 W2d 778, 314

P2d 672, 675-677 (1957).

Miller as a key employee was a fiduciary and his employer was relying upon him to come up with the answer to the plugging problem that would allow for continued use of unslotted knives. When Miller found that solution he kept it to himself and went into competition with his company. A more classic example of breach of trust could not be found.

ALTER EGO

In 1918 District Court, N.D. Ill, examined the relationship to the company of one Dowse who "did not expressly contract as part of his duties to design..." Determining if he "did so agree in substance and was more than a mere employee, having the main responsibility to make the business successful"...the court said "...the real test is whether Dowse occupied such a relation to the corporation

that he was its alger ego, in such a capacity that it is only consistent with good faith that he should recognize its ownership of the patent issued to him. Can he, without breach of his obligation toward his late employer, insist upon retaining and enforcing against it the patent he took out." Dowse v. Federal Rubber Co., 254 F 308, 310 (1918).

Melin v. U.S., 478 F2d 1210, 178 USPQ 364 (1973) held that the alter ego theory of Dowse was determinative upon the relationship that existed between the employer and the inventor at the time of the invention -- not before or after. The alter ego theory differs little from the implied agreements to assign discussed previously. It also reinforces the need for the employee to be more than a general employee and emphasizes good faith. Melin places the focus on the relationship at the time of the invention and the conditions

of employment at that time.

DEFENSES

Meady Agreement. Defendant's position is based mostly upon an alleged oral agreement between Meady and Miller (formulated prior to Meady's death, Mainland's acquisition, or the '78 patent) that allowed Miller to keep as his own any patents "invented on his own time, money, and material." (Defendant's post trial memo p. 3, l. 24). The only evidence that such an agreement ever existed is Miller's word. Contrary to the defendant's arguments Miller's past practice does not bear it out nor does the case law or practices of the engineering profession.

The case law holds:

> "It matters not in what capacity the employee may originally have been hired, if he be set to experimenting with the view of making an invention, and accepts pay for such work, it is his duty to disclose to his employer what he discovers in making the

> experiments, and what he accomplishes by the experiments belongs to the employer ..." Houghton, 390, Marshall, 389.

Furthermore, an agreement "cannot be interpreted as encompassing a rights to engage in disloyal acts during the course of [defendant's] employment." Standard Brands, 172. In speaking of agreements that would appear to leave one party completely at the mercy of another the Oregon court said (citing Cardozo in Moran v. Standard Oil, 211NY 187, 105 NE 217 (1924). "An invention to make so one-sided an agreement is not to be inferred." Perkins v. Standard Oil Co., 235 Or 7, 16, 383 P.2d 107 (1963).

Miller's actions belie the existence of such a blanket understanding. His own practice and testimony proves that he assigned many patents in the past and that in his mind the '73 knife holder patent was "assumed" without question, to

be the property of the company. Bear in mind in 1978 Miller was chief engineer exclusively and in 1973 he wore the caps of chief engineer, corporate office, field representative, slaesman (sic), and trouble shooter. Miller cannot consider his work on knife holders to be without question that of the company while a parttime engineer and at a later date consider his work on knife holders to be his own when he is full time chief engineer assigned to work on the knife holder problem and effect solutions. None of the patents not assigned related to chippers. Those that did were assigned (excluding the 78 model). Prior to 1978 Miller gave notice (disclosed) all the work he was doing on patents apart from his duties at CM&E (Defendant's memo p. 4, l 13-21) and received approval from the company. There is no doubt that Miller treated the '78 patent differently than any other he

large, that patents relating to corporation business would be assigned. The alleged agreement cannot be controlling. Based upon the testimony and the evidence this court finds more reliable, I find, as a fact, there was no such agreement.

PAID TO INVENT

It has been established (above) that one need not be paid exclusively to invent in order for there to be a duty to assign. However, defendants placed a great deal of emphasis on Miller's contention from the stand that he was paid to design -- not to invent so that distinction must be answered.

Joe Lomnici and Robert Hill testified and Miller equivocated that "design" in the engineering field included inventing if the design idea was one which qualified as a patent. Miller's semantic game is to no avail. He admits he was

paid to design and design as used by his profession and understood by his employer includes inventing. "If there is a plain, ordinary , and proper meanign of a term, that is evidence of how the parties intended to use that term. Similarly, trade or business usage is also relevant." (3 Corbin on Contracts § 542 at 108, § 538 at 68-69,) Jamesbury Corp. v. Worchester Valve Co., 443 F2d 205, 210, 170 USPQ 177 (1971). The Oregon court has held that the term "design" as used in patent law refers to "ornamental design" for an item of manufacture. Portland Iron Works v. Willett, 49 Or 254, 89 P 421 (1907). Surely Miller, in choosing the term design to describe his work, does not contend he was hired to make ornamental or aesthetic innovations in CM&E's equipment. Willett, 256 held that when the defendant did in fact devise and invent products the term design must be construed accordingly.

HOURS

Defendants went to great length to show that the work done on the '78 patent was done exclusively at home during off duty hours and not in connection with the business of CM&E. The evidence tends to support an assertion that the work was accomplished outside of what has come to be known as the standard eight hour day. The testimony, however, of Miller and others in his field as well as the case law indicates the assertion is not controlling. Miller admitted he "might" have thought about the '78 patent while on duty at CM&E. In this court's opinion it is impossible for Miller to control his thought processes to such a fine point that he can keep separate "his" work from "their" work and never the twain meet. Miller testified that his hours with CM&E were not regular, that they would vary according to the needs of the

job and that often he took work home after hours. The evidence indicates that in the engineering field a salaried employee's job related time at home or at work is his employer's.

Miller was hired at an agreed upon remuneration (sic), regardless of the specific hours needed, to get the job done. He was not hired at an hourly rate nor was he in a position where he could just walk totally away from his work when the whistle blew and keep it separate from CM&E related business. National Development v. Gray, 55 NE 2d 783, 788, 316 Mass 240 (1944) the defendant drew plans to company related business while at home. The court held "even though the drawing was prepared in his own home, we think it came within the scope of his employment... and that it belonged to [plaintiff] no less than if the drawings was made at [plaintiff's] shop."

Toledo Machine and Tool Co. v Byerlein, 9 F2d 279, 281 (6th in 1925) held ... "We do not consider the claim made by defendant that he developed the patentable idea at night as of the slightest importance. His salary was paid ... for the month. Certainly under the [employment] contract it would make no difference what time in the day or night such ideas were developed."

Daniel Orifice (supra 666) held "it is difficult to understand how [defendant] could cut his mind off and on at will under the circumstances, i.e. think of things during the lunch hours, for example, which would constitute an improvement to [plaintiff's] product, and later claim such improvement as his own because he was not working for the company at that particular moment when the thought struck him."

BAD FAITH

In this case something must be said regarding Miller and Swafford's apparent bad faith. By the evidence it was only on the '78 patent that Miller pursued a secret course of action. All other inventions were disclosed without any problems. The Court can only surmise that Miller was trying to hide his activity from his employer. PAR 820-20-005(1) addresses the type of conduct:

"Integrity: The Engineer shall act with integrity in professional matters for each client or employer as a faithful agent or trustee. He shall be honest and impartial, and shall serve the public, his client, and his employer with equal devotion."

Furthermore, the fact that the '78 patent is interchangeable with all of CM&E's bent knife chipper heads (slotted or unslotted) is more than coincidence.

Miller did not invent the '78 patent just for fun. The evidence indicates very strongly that at the time the '78 patent was formulated it was intended as a replacement part for CM&E's then existing line of products. This combined with Miller's and Swafford's taking of documents not rightfully theirs adds up to bad faith and unclean hands and this Court cannot condone such activities.

For the above stated reasons this Court finds the patent to rightfully belong to CM&E (mainland (sic)). However, under the general powers of equity, this Court grants to Miller a nonassignable license to use the '78 patent. This is done because Miller, had he have been truly larcenous, could have handled the matter with more cunning and probably have succeeded. What a man carries away in his mind from a former position of employment is usually his unless there is a signed

covenant not to compete for a specific (relatively short) duration. No company can lay claim to expertise gained and knowledge gleened from ones employment as a man's education and knowledge are uniquely and unqualifiedly his. Miller wanted the patent for his own. He just went about it in the wrong way. Establishing proper ownership is adequate remedy for Mainland and granting Miller license to use it is equitable allowance for the continued position as a leader in the field his ingenous device puts Mainland in. This Court is not saying Miller's actions were not wrong. However, had he handled it differently, ownership might be his and it is only equitable in that light that Miller enjoy some of the fruits of his labor and recover something for his diligence in spending weekends and evenings reducing the idea to a tangible form and for paying for the expense of the copy-

righting (sic) it.

ISSUE II

Should the documents taken by defendants be returned.

CONCLUSION

The existence or nonexistence of trade secrets in the documents is not determinative. The documents were the property of CM&E and the defendants had no right to take them. They should be returned to CM&E/Mainland.

DISCUSSION

There is no contradiction in the evidence that the materials taken were other than the property of CM&E or assimilated by defendants during and in the course of their employment with CM&E.

Midland-Ross Corp v. Yokana, 185 F Supp 594, 604 (D NJ 1960) affirmed 293

F2d 411 (1961) held in a similar case "...[Defendant] had no right to retain drawings or blueprints which were property of his employer after the termination of his employment, nor had he any right to retain or use his employers customer lists, price lists, or pricing data for his own... [P]laintiff is, therefore, entitled to the return to it by the defendants all drawings and blueprints [taken]."

The Midland view is consistent with the view that what one is paid for becomes the property of his employer." When an employee does what he is hired to do, his successes as well as his failures, belong to his employer." Crown Cork and Seal Co v. Fankhalel., 49 F Supp 611, 615 (DDM 1943). This is in line with the Code of Ethics-Professional Engineers of Oregon § 14 (d) "Designs, data, records, and notes made by an engineer and referring

exclusively to his employees work are his employees property." Standard Brands, (Supra at 172) held "continued use of ... drawings following termination of defendant's agency ... is also wrongful use and retention of drawings by [defendant] constitutes misappropriation of plaintiff's property.

The materials retained by Swafford fall in the same general type of documents as Millers. They were promulgated during and in the course of his employment Swafford has no claim to these materials as they came to be a result of his tenure with CM&E and the service to them that he was paid for. These must be returned. It may be argued, return of these documents offers little recompense to plaintiff's considering the years of trial and error and expense incurred by CM&E in the cost estimates. There is little insulation any employer hsa to retain the loyalty and fidelity of an ambitious employee.

Suffice it to say, plaintiff hired Swafford -- they made it possible for the present situation to germinate -- the result naturally followed.

Turning to the request of defendants for special Findings of Fact, I submit.

1) Yes. However, question 3 should be requested first because this answer is given within the definition of question 3. The drawings, plans, specifications submitted to the varoius machine works were clearly "secrets" of the plaintiff, having been developed over several years of trial - and - error. True, the finished product may not have been a "secret" but all the data on which the parties relied was confidential and secret. Just the same with their cost estimate and the data relating to all aspects of costs would constantly

be used in the scheme of competitive bidding.

2) Yes. See answer to 1).

3) I define a trade secret in several different ways but in this case, it is that information obtained by an owner through trial and error. It is the result of his own research in his particular field for the purpose of developing a more competitive product. It is knowledge beyond that known by the general public and short of being applied in the finished product.

4) No. Personal letters sent and received, things of that nature, yes, but not the documents called to the attention of and deposited with the Court.

5) Yes. In my opinion there was injury suffered by plaintiff but it was not proved in dollars.

6) Yes. Miller was the chief engineer. He was in charge of machinery design as well as its operation. During the time of his tenure with CM&E, he probably made some improvement on every machine they sold. When a problem arose, it was Miller who was expected to correct it. Because a patent was not taken out on each improvement he made, would not change the characterization of his work. Certainly, this includes "design." In this situation, there is little fiference (sic) between "design" and "invent". The facts showed, if a machine did not do the work it was designed to do, then Miller was to change it - either design or a new approach. I concede he was not hired to spend his time experimenting with models so that a patent could be taken out.

that point he was hired by plaintiff, in the capacity of Chief Engineer and was placed in charge of plaintiff's engineering department. He remained so employed until his retirement in February, 1978.

II.

Defendant E. H. Swafford was hired by plaintiff in January, 1976, as its Chief Accounting Officer. He remained so employed until August 1977 when he quit.

III.

Plaintiff Mainland Industries, Inc. is a Delaware corporation. On December 3, 1975 plaintiff acquired all of the assets of Chipper Machiens & Engineering Corp. and became the successor to all of that company's rights and interests.

IV.

Defendant Fred Miller's employment duties as plaintiff's and its predecessor's Chief Engineer included:

(a) inventing, designing, developing, and engineering products and improvements produced and sold by those companies.

(b) solving problems arising in connection with the use and design of the companies' products by inventing, designing, developing, and engineering improvements and modifications to prevent such problems from recurring in the future;

(c) assigning to his subordinates in the engineering department specific projects on which to work, including inventing, designing, developing, and engineering various products, solving various problems with existing products, and improving existing products.

(d) making it possible for those companies to reduce facturing (sic) costs for products and increase

profits;

(e) working with each company's patent attorney to secure appropriate patent protection for inventions, developmentes, and designs of the kind set out above in subparagraphs (a) through (d) above and assigning to the companies all rights to those patents; and,

(f) serving as an officer and director of Chipper Machines beginning in 1973 until the acquisition by plaintiff.

V.

Defendant Miller was employed by plaintiff or its predecessor when he conceived the idea for the 1978 patented knifeholder. Although he first testified that he invented the knifeholder in mid 1976 while he was employed by plaintiff, he later stated that he conceived the idea in mid 1975 while employed by plaintiff's

predecessor as Officer, Director, and Chief Engineer. Regardless, Miller was employed by plaintiff while he made modification in his original idea and when he prepared the drawings and made application for the patent.

Miller was not able to recall where he was when he conceived the idea for the 1978 patented knifeholder, but it seemed likely to him that he thought about it at work.

VI.

Miller was a salaried employee. His employment was not limited to specific hours and it was his practice to work evenings for his employer both at and away from his employer's premises.

VII.

Miller had a duty while employed by plaintiff and its predecessor to:

(a) work on correcting the knife-holder if there were complaints about

its efficiency or operation or to improve its performance.

(b) devote the time required to a project if a patent was within reasonable contemplation.

(c) assign work for improving the knifeholder to other trusted persons in his department if he did not have the time to do it himself.

(d) follow up on (c) and see that the problem were solved.

(d) (sic) disclose all ideas to his employer that were relevant to its products.

(e) (sic) not work secretly in competition with his employer and

(f) (sic) assign the patent on the 1978 knifeholder to plaintiff.

VIII.

That he had no binding agreement with Meady that would allow him to keep all inventions and that such an agreement,

regardless what it was, would not be binding on plaintiff.

IX.

As a professional engineer Miller was obliged to seek an express agreement with plaintiff if he wished to retain for himself any patents on improvements to plaintiff's product line, if he wished to compete with plaintiff on his own time, and if he wished to alter his basic duties of loyalty and as a trustee of plaintiff's interests.

X.

When Miller left plaintiff's employ, he took with him engineering records owned by plaintiff. The documents contain information not generally known to plaintiff's competitors which gives plaintiff an advantage over those competitors who do not know the information. Information contained in the documents was developed at great expense to plaintiff

and its predecessor. The documents would be very useful to anyone attempting to duplicate plaintiff's products or to compete with plaintiff, particularly defendants. The documents also contain information that plaintiff needs to operate its business. The documents that should be returned to plaintiff are Exhibits 62, 63, 68-73, 75-75-78, 80-100, 102A, 104-129, 132-33, 136-143, 146-149.

XI.

When defendant Swafford left plaintiff's employ, he also took financial and accounting records owned by plaintiff. These documents contain financial and cost information not generally known to plaintiff's competitors which gives plaintiff an advantage over those competitors who do not know or use it. Information contained in the documents was developed at great expense to plaintiff. The documents would be very useful to anyone attempting to

duplicate plaintiff's products or to compete with plaintiff, particularly defendants. The documents that shall be returned to plaintiff are Exhibits 33-61.

CONCLUSIONS OF LAW

1. The Court has jurisdiction of the parties and subject matter.

2. Plaintiff is declared to be the owner of patent #4,082,127 (the 1978 knifeholder) and Miller shall assign all ownership in the same to plaintiff.

3. Miller shall have an equitable non-assignable right to the free use of the knifeholder, either into himself or a company he may form or be associated with (such as CM&E for his life. This right of Miller to the free use of the knifeholder shall terminate upon his death and may not be transferred, assigned, or bequeathed to any other person or company.

4. The documents, Exhibits 62, 63, 68-73, 75-78, 80-100, 102A, 104-129, 132, 133, 136-143, 146-149 and 33-61 shall be returned to plaintiff.

5. In favor of defendants on plaintiff's claims for damages.

6. In favor of plaintiff on defendants' counterclaim.

Dated this 3rd day of September, 1980.

/s/ DALE JACOBS
Judge

IN THE SUPREME COURT OF THE
STATE OF OREGON

MAINLAND INDUSTRIES, INC., a Delaware corporation,	)	
Respondent on review	)	Trial Court No. 78-6-90
v.	)	
TIMBERLAND MACHINES AND ENGINEERING CORPORATION, an Oregon corporation, E. H. SWAFFORD, F. L. MILLER and JOHN DOES 1 through 20,	)	Appellate Court No. 19614
Petitioners on review	)	

The Supreme Court on November 2, 1982, denied petitioners' Petition for Review in the above-entitled matter.

This letter constitutes the order of the Supreme Court denying the petition.

Office-Supreme Court, U.S.
FILED
MAR 3 1983
ALEXANDER L. STEVAS,
CLERK

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1982

No. 82-1274

TIMBERLAND MACHINES AND ENGINEERING CORP., E. HOWARD SWAFFORD, FREDERICK L. MILLER,

Petitioners,

v.

MAINLAND INDUSTRIES, INC.,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE COURT OF APPEALS OF OREGON

RESPONDENT'S BRIEF IN OPPOSITION

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INDEX

	Page
QUESTIONS PRESENTED	1-2
STATEMENT OF FACTS	2-7
1. Procedural Background	2-3
2. Factual Background	3-7
REASONS FOR DENYING THE PETITION	7-14
1. No Federal Question Has Been Presented	7-12
2. Even If There Were A Federal Question Involved, Petitioners Would Be Barred From Seeking Review Since They Never Properly Presented And Preserved Any Such Questions .	12-14
CONCLUSION	14-15

TABLE OF AUTHORITIES

	Page
Cases:	
Becher v. Contoure Laboratories, Inc., 278 U.S. 388 (1929)	8
Cardinale v. Louisiana, 394 U.S. 437 (1969)	13
Goodyear Tire & Rubber Co. v. Ray-O-Vac Co., 321 U.S 275 (1944)	12
Graver Tank & Mfg. Co. v. Linde Air Products Co., 339 U.S. 605 (1950)	11
Lear, Inc. v. Adkins, 397 U.S. 653 (1969)	8
United States v. Dubilier Condenser Corp., 289 U.S. 178 (1933)	8, 9, 10 11, 13, 14
United States v. Johnson, 269 U.S. 220 (1925)	12
Statutes:	
28 U.S.C. § 1257(3)	7, 8, 9
ORS 19.125(3)	3

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Respondent.

RESPONDENT'S BRIEF IN OPPOSITION

Respondent Mainland Industries, Inc., respectfully requests that this Court deny the petition for writ of certiorari, seeking review of an opinion of the Oregon Court of Appeals. That opinion is reported at 58 Or. App. 585, 649 P.2d 613 (1982).

QUESTIONS PRESENTED

1. Does petitioner present a federal

question.

2. If there is a federal question involved, was it properly preserved before the state courts.

STATEMENT OF FACTS

1. Procedural Background.

This case was originally commenced by Mainland to obtain title to a patent on an improvement to one of its products. The patent had been issued to petitioner Miller, Mainland's former chief engineer, as a result of work performed by him while still an employee of Mainland. The action was tried before the Circuit Court of the State of Oregon, County of Clackamas, sitting in equity. Trial lasted 7 days. Petitioners were at all times represented by counsel. Based upon the evidence presented, the Circuit Court issued a 31 page opinion, holding that the patent properly belonged to Mainland. It granted to petitioner Miller, however, a lifetime, non-assignable license to use the patent.

Mainland appealed and petitioners cross-appealed. The Oregon Court of Appeals affirmed the trial court's holding that the patent belonged to Mainland, and reversed the grant of a lifetime license to petitioner Miller. The court found that the grant was unprecedented and that Miller's bad faith and unclean hands barred any equitable relief. Petitioners sought a rehearing before the court of appeals and review by the Oregon Supreme Court. These requests were denied.

Under Oregon law, the Court of Appeals could have altered the trial court's findings of fact because its review is de novo, but found no reason to do so in any material way. Ore. Rev. Stat. 19.125(3).

2. Factual Background.

The Statement of the Case contained in petitioners petition for certiorari contains a number of factual statements directly contradicted by the findings of the trial court and the Oregon

Court of Appeals. Among the inaccuracies are the following:

A. Petitioner Miller was not simply hired in a general capacity. Cf. Petition, at 3, 24. The trial court found that Miller's duties specifically included inventing improvements and developments to enhance Mainland's product line. Trial Court's Findings of Fact IV (a) and (b), Petition, at A-86.

B. Miller had no agreement with Mainland or its predecessor that permitted him to keep patents on all inventions made on his "own time, money, and facilities." Trial Court Findings of Fact VII, VIII, IX, Petition, at A-89 - A-90; cf. Petition, at 6, 19. The Oregon Court of Appeals concluded that "the parties intended that Miller would assign to Mainland any patents directly related to his employer's product line." Court of Appeals Opinion, Petition, at A-14 - A-15.

C. It was petitioner Miller's responsibility as Chief Engineer to identify problems in Mainland's product line and to either solve them himself or to assign the problems to a subordinate for solution. Trial Court's Findings of Fact IV (b) and (c), Petition, at A-86; cf. Petition, at 11.

D. This responsibility specifically included the obligation to work on correcting any deficiencies in the 1973 Knifeholder (which had been patented earlier by Miller and assigned to Mainland). Trial Court's Findings of Fact VII (a) through (d), Petition, at A-88 - A-89.

E. Petitioner Miller was aware of the difficulties being encountered by Mainland's customers when using the 1973 Knifeholder. Trial Court's Memorandum Opinion, Petition, at A-47; cf. Petition, at 9-11.

F. The 1978 patented Knifeholder would have solved the problems that Mainland's customers were

having with the 1973 Knifeholder. Trial Court's Memorandum Opinion, Petition, at A-47 - A-48; cf. Petition, at 11, n. 4.

G. Miller had an obligation to disclose to Mainland all ideas that were relevant to its product line and not to work secretly in competition with Mainland. Trial Court's Findings of Fact VII (d) and (e), Petition, at A-89.

H. When asked to work on solving these problems, Miller responded that there was no known solution, even though he had already conceived of the improvements that led to the 1978 patent. Court of Appeals Opinion, Petition, at A-4.

I. Miller breached his professional and fiduciary obligations to his employer by failing to disclose to Mainland the new invention that would solve the problems of the 1973 Knifeholder. This, together with his taking of documents belonging to Mainland in order to set up a competing company, constituted bad faith and

unclean hands. Trial Court's Memorandum Opinion, Petition, at A-75 - A-76; Court of Appeals Opinion, Petition, at A-17 - A-18.

REASONS FOR DENYING THE PETITION

1. No Federal Question Has Been Presented.

This case does not involve any issues wherein the validity of a treaty or a statute of the United States is drawn in question or where the validity of a state statute is challenged as being repugnant to the Constitution, treaties or laws of the United States. Nor is there involved any title, right, privilege or immunity set up or claimed under the Constitution, treaties, statutes, commissions or authority of the United States.[1] 28 U.S.C. § 1257(3).

1. Although petitioners cite U.S. Const. Art. I, § 8, cl. 8 and U.S. Const. Amend. XIV, Petition, at 2-3, 12, no suggestion is ever made that the questions involved fall within the purview of these provisions, except to the extent petitioners claim there has been a deprivation of property without due process. If that argument were sufficient, every dissatisfied party in a state

The only issue involved here is whether a private employer is entitled to a patent developed by an employee during the course of his employment and as a part of his duties to his employer. This is solely a question of state law. This was recognized by this Court in United States v. Dubilier Condenser Corp., 289 U.S. 178 (1933), the case relied upon by petitioners. This Court said:

> The respective rights and obligations of employer and employee, touching an invention conceived by the latter, spring from the contract of employment. [Emphasis added.] 289 U.S. at 187.

See also, Lear, Inc. v. Adkins, 395 U.S. 653, 661-62 (1969) (construction of patent licensing agreement is solely a matter of state law and issue is not open to Court); Becher v. Contoure

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1. (cont'd) civil action could present a federal question.

The only federal statute cited by petitioners is 28 U.S.C. § 1257, in their section entitled "Jurisdiction." Petition, at 2. No citation is made to any federal patent laws.

Laboratories, Inc., 279 U.S. 388, 390-91 (1929) (where employer sought assignment of patent from employee based upon breach of contract or wrongful disregard of confidential relations, patent laws did not apply and state court had jurisdiction).

Petitioners themselves have conceded that no federal question is presented:

> In determining entitlement to an invention as between an employer and an employee, absent an employment contract, title to the invention of an employee is governed by the traditional common law of master-servant. [Emphasis added.] Petition, at 14.

As such, this Court has no jurisdiction and certiorari would be inappropriate. 28 U.S.C. § 1257 (3).

While petitioners cite this Court's opinion in United States v. Dubilier Condenser Corp., 289 U.S. 178 (1933), that decision is not on point. The only reason that Dubilier was even in the federal court system was that the United States

was a party. Since then, the President, acting pursuant to statute, has issued an Executive Order dealing with the ownership of patents developed by government employees. Exec. Order No. 10,096, 15 Fed. Reg. 389 (1950), as amended by Exec. Order No. 10,695, 22 Fed. Reg. 365 (1957); Exec. Order No. 10,930, 26 Fed. Reg. 2583 (1961); reprinted following, 35 U.S.C.A. § 266. Congress has left to the States the question of ownership of patents developed by employees of private companies. That is the situation here, and there is no need for this Court to intervene.

The real heart of petitioners' argument is not that the Oregon courts did not follow United States v. Dubilier Condenser Corp., supra, but rather the Oregon courts made two findings of fact that petitioners want this Court to change: (1) that petitioner Miller was hired to invent, and (2) that petitioner Miller had no agreement with his employer that permitted him to keep the 1978

Patent. Petition, at 17. In Dubilier, the employees were not hired to invent. 289 U.S. at 193-95. The Court noted that where an employee is hired to invent, as here, the employer is entitled to any resulting patents.[2] 289 U.S. at 187.

What petitioner is really asking this Court to do is to review the entire factual record of this case, and then to substitute its own findings of fact for those of the Oregon courts. It would be inappropriate for this Court to grant a petition for certiorari for these reasons. Graver Tank & Mfg. Co. v. Linde Air Products Co., 339

2. In Dubilier, the subject inventions were completely independent of the work for which the inventors were employed. The inventions were not involved in or suggested by the problems with which the section in which they were employed was involved, nor had the inventors been assigned the tasks by their superior. 289 U.S. 178, 185. In this case, the 1978 Knifeholder is at the very heart of Mainland's product line. The solution to the problems plaguing the 1973 Knifeholder was of fundamental importance to Mainland and, as Chief Engineer, it was petitioner Miller's job, and no one else's, to assign the task of finding the solution, or to solve the problem himself.

U.S. 605, 609-10 (1950) (trial court's Findings of Fact should not be disturbed unless clearly erroneous); Goodyear Tire & Rubber Co. v. Ray-O-Vac Co., 321 U.S. 275, 278 (1944) (must be strong case where Court will set aside concurrent findings of fact by court of appeals and trial court); United States v. Johnson, 268 U.S. 220, 227 (1925) ("We do not grant a certiorari to review evidence and discuss specific facts.").

2. Even If There Were A Federal Question Involved, Petitioners Would Be Barred From Seeking Review Since They Never Properly Presented And Preserved Any Such Questions.

At no time have petitioners ever suggested to the Oregon courts, either at the trial or appellate level, that petitioners were asserting any claim or were denied any right arising under federal law. They alleged no violation of due process of law. They never raised any federal statute or Constitutional provision as a ground for relief, or as having preempted state law.

On the contrary, they proceeded at all times as if the questions involved herein were solely matters of state law. Petitioners own citations to points in the case where they claim federal questions were raised, Petition, at 12-14, only go to show that no federal question was raised, and that United States v. Dubilier Condenser Corp., 289 U.S. 178 (1933) was raised for its precedential value and nothing more.

That being the case, it would be inappropriate for this Court to grant the petition for certiorari. This Court has repeatedly held that federal questions cannot be raised for the first time before this Court. E.g., Cardinale v. Louisiana, 394 U.S. 437, 438-39 (1969):

> It was very early established that the Court will not decide federal constitutional issues raised here for the first time on review of state court decisions. ...
>
> In addition to the question of jurisdiction arising under the statute controlling our power to review final

judgments of state courts, 28 U.S.C. § 1257, there are sound reasons for this. Questions not raised below are those on which the record is very likely to be inadequate, since it certainly was not compiled with those questions in mind. And in a federal system it is important that state courts be given the first opportunity to consider the applicability of state statutes in light of constitutional challenge, since the statutes may be construed in a way which saves their constitutionality. Or the issue may be blocked by an adequate state ground.

CONCLUSION

No federal question has been presented or properly preserved. The issues are solely matters of fact and state law. The holding in this case is not in conflict with this Court's decision in United States v. Dubilier Condenser Corp.. No satisfactory reason has been given to upset the decision of the Oregon Court of Appeals and a writ of certiorari would be inappropriate.

DATED this 2nd day of March, 1983.

Respectfully submitted,
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